

REMARKS

I. STATUS OF THE APPLICATION

Claims 1-33 were originally filed in the present case. Claims 34-44 were added in a Preliminary Amendment mailed May 14, 2004. In an Amendment accompanying the Response to Office Action mailed May 17, 2005, the Applicants cancelled claims 1-44, and added claims 45-83. In an Amendment and Response to the Final Office Action of October 13, 2006 the Applicants amended claims 45 – 49, 74 and 75.

Claims 48, 49, 55-72, and 81-83 have been withdrawn from consideration by the Examiner. In the present Amendment and Response to the Office Action of March 30, 2007 claim 75 is amended. Therefore, claims 45-47, 50-54, and 73-80 are currently pending.

II. REJECTIONS

For clarity, the rejections are set forth in the order that they are addressed by the Examiner.

A. 35 USC §112

In the Office Action of March 30, 2007 the Examiner notes:

“Claim 75 recites the target acquisition device comprising a reticle comprising specific cross-hairs, it is not clear if this is the same reticle that has already been cited and claimed in claim 45 (on which 75 depends and incorporates all limitations of) or applicant intends an additional reticle. It is noted that applicant has not disclosed a ballistics calculator system comprising two reticles.

Appropriate correction is required.” (Office Action of March 30, 2007, page 2.)

The Applicant’s respectfully disagree. However, in order to expedite the patent

application process in a manner consistent with the U.S. Patent and Trademark Office's Patent Business Goals (PBG)¹, and without waiving the right to prosecute the amended or cancelled claims (or similar claims) in the future, in the present Amendment and Response to Final Office Action of March 30, 2007, claim 75 is amended herein to read:

“The ballistics calculator system of claim 45, wherein said target acquisition device, comprises: a) a housing; and b) a means for mounting said housing in a fixed, predetermined position relative to a firearm”

In view of the above, the Applicants request that this rejection be withdrawn.

B. 35 USC §102

In the Office Action of March 30, 2007, claims 45-47, 50, 51, 53 and 73 are rejected as allegedly being anticipated by Heidmann *et al.* (US Patent 4,671,165) (hereinafter “Heidmann”). (Office Action of March 30, 2007, page 3.)

The Federal Circuit has stated the relevant analysis for anticipation as follows:

"A claim is anticipated only if each and every element as set forth in the claims is found, either expressly or inherently described, in a single prior art reference."²

The Applicants respectfully submit that the reference cited by the Examiner fails to teach each and every element as set forth in the claims.

In the Office Action of March 30, 2007 the Examiner notes:

“Heidmann et al. discloses a ballistics calculator system for computing targeting information to hit a target, comprising a processor, the processor comprising a ballistics computer program for analyzing information to accurately aim a firearm at a target using a target acquisition device with a reticle, the program using

¹ 65 Fed. Reb. 54603 (Sept. 8, 2000).

² *Verdegaal Bros. V. Union Oil of California*, 2 USPQ2d 1051, 1053 (Fed.Cir. 1987).

information regarding the target acquisition device and reticle being used, wherein the type of the target acquisition device and reticle comprise, a reticle comprising a plurality of simultaneously visible secondary cross-hairs at predetermined distances along a simultaneously primary visible cross-hair and a plurality of simultaneously visible secondary vertical cross-hairs at predetermined distances along at least some of the simultaneously visible secondary horizontal cross-hairs and an output using the visible secondary horizontal cross-hairs and visible secondary vertical cross-hairs to identify an aiming point for hitting a target. At least some of the visible secondary horizontal and visible vertical cross hairs are evenly spaced and are connected to form a grid (Figure 2.)” (Office Action of March 30, 2007, page 3.)

The Applicants respectfully disagree. Contrary to the Examiner’s arguments Heidmann does not teach or suggest a reticle with a plurality of visible secondary vertical cross-hairs at predetermined distances along at least some of the visible secondary horizontal cross-hairs of the present application. For example, the reticle of Figure 2. of Heidmann does not depict, teach or suggest even one visible secondary vertical cross-hair along even one visible secondary horizontal cross-hair. Nor does Heidmann’s Figure 2. depict, teach or suggest a plurality of visible secondary vertical cross-hairs along at least some visible secondary horizontal cross-hairs. Similarly, not one of Heidmann’s other reticles depicts, teaches or suggests a plurality of visible secondary vertical cross-hairs at predetermined distances along at least some visible secondary horizontal cross-hairs of the present application. Nor are the reticles of the present application to be found elsewhere in Heidmann’s drawings, specification or claims.

The rejection under 35 USC §102 of the Office Action of March 30, 2007 does not indicate where the Examiner has located these elements in Heidmann. The reason for this deficiency is that the claimed elements are nowhere to be found in Heidmann. Unless the Examiner is able to identify each and every element of the claims *i.e.*, a plurality of simultaneously visible secondary vertical cross-hairs at predetermined distances along at least some simultaneously visible secondary horizontal cross-hairs at predetermined distances along a simultaneously visible primary vertical cross-hair, the Examiner’s

rejection must fail.

In addition, Heidmann does not teach or suggest the limitation “an output using said secondary horizontal cross-hairs and said secondary vertical cross-hairs to identify an aiming point for hitting the target”. Heidmann does not teach or suggest the visible secondary horizontal cross-hairs and visible secondary vertical cross-hairs of claim 45.

Clearly, Heidmann is missing not just one but multiple elements of the claims set forth in the present application. Accordingly, Heidmann does not teach or suggest the ballistics calculator system of the present application.

In view of the above, the Applicants request that this rejection be withdrawn.

C. 35 USC §103(a)

A *prima facie* case of obviousness requires the Examiner to cite to a reference which a) discloses all the elements of the claimed invention, b) suggests or motivates one of ordinary skill in the art to combine the claim elements to yield the claimed invention, and c) provides a reasonable expectation of success should the claimed combination be carried out. Failure to establish any one of these three requirements negates a finding of a *prima facie* case and, without more, entitles the Applicants to allowance of the claims in issue. (MPEP)

1. Moore in View of Reese

In the Office Action of March 30, 2007, claims 45 and 75-80 are rejected under 35 USC 103(a) as allegedly being unpatentable over Moore (US Patent #4,965,439) (hereinafter “Moore”) in view of Reese (US Design Patent #Des. 306,173) (hereinafter “Reese”).

a. Missing elements in the Examiner’s Combination of Moore plus Reese

In the Office Action of March 30, 2007 the Examiner notes:

“Although Moore does not expressly disclose the reticle comprising a plurality of simultaneously visible secondary horizontal cross-hairs at predetermined distances along a simultaneously primary visible vertical cross-hair and a plurality of simultaneously visible secondary vertical cross-hairs at predetermined distances along at least some of the simultaneously visible secondary horizontal cross-hairs and an output using the visible secondary horizontal cross-hairs and visible secondary vertical cross-hairs to identify an aiming point for hitting the target. The reticle comprises a simultaneously visible primary vertical and simultaneously visible horizontal cross-hair, Reese does. Reese teaches a reticle having the specified cross-hairs and secondary cross-hairs.” (Office Action of March 30, 2007, page 4.) (Emphasis added.)

The Applicants respectfully disagree. Contrary to the Examiner’s arguments, Moore in view of Reese does not teach or suggest the limitation “an output using said secondary horizontal cross-hairs and said secondary vertical cross-hairs to identify an aiming point for hitting the target” of claim 45, and claims 75-80. Reese does not teach or suggest an output. Reese does not teach or suggest an output using said secondary horizontal cross-hairs and said secondary vertical cross-hairs. Reese does not teach or suggest identification of an aiming point. Reese does not teach or suggest identification of an aiming point for hitting a target. The Examiner has not indicated, and cannot indicate, where these elements are to be found in Reese. Indeed, Reese is a design patent in the decorative arts. The components of Reese are ornamental and are not dictated by functional considerations. Accordingly, Reese provides no teachings or suggestions for use of its non-functional, ornamental design in the ballistics calculator system of the present application. Thus, Reese cannot remedy the defects in Moore that the Examiner has conceded in the Office Action of March 30, 2006.

Clearly, Moore in view of Reese is missing not just one but multiple elements of the claims set forth in the present application. Accordingly, Moore in view of Reese does not teach or suggest the ballistics calculator system of the present application.

In view of the above, the Applicants request that this rejection be withdrawn.

b. The Examiner Provides no Motivation to Combine Moore and Reese

In the Office Action of March 30, 2007 the Examiner notes:

“Moore and Reese are analogous art because they are from the same field of endeavor: sighting devices. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the reticle with the specific cross-hairs as suggested by Reese with the ballistic calculator as disclosed by Moore. The suggestion/motivation for doing so would have been to obtain an optical instrument that had an improved reticle as suggested by Reese.” (Office Action of March 30, 2007, pages 4-5.)

The Applicants respectfully disagree. Alone or in combination, Moore and Reese fail to teach, suggest or motivate the ordinary artisan to make the Examiner’s combination of references. The Examiner does not, and cannot, point to which specific teachings in the cited references motivate the ordinary artisan to combine the claimed elements thereby arriving at the ballistics calculator system of the present application. Nor has the Examiner provided any other evidence that teaches or suggests the Examiner’s combination. The Examiner’s requirement to provide evidence of the motivation to combine the Examiner’s references is absolute.³ In the Final Office Action of March 30, 2007 the Examiner has provided no supporting objective evidence sustaining the Examiner’s speculations with regard to what an ordinary artisan would or would not have been motivated to do.

Moreover, Moore expressly teaches away from the reticle of Reese. To the contrary, Moore’s reticle is:

“a sighting reference, or reticle comprising a vertical cross-hair **19** and a horizontal cross-hair (not shown).” (Moore, column 8, lines 5-7.) (Emphasis added.)

³ *In re Kotzab*, 217 F.3d 1365, 1369-70, 55 USPQ2d 1313, 1316 (Fed. Cir. 2000).

And:

“a reticle frame **39**, a horizontal cross-hair **40** and a vertical cross-hair **41**. These are essentially identical to those components found in conventional scopes and are shown in their relative positions along the optical axis **35** of the scope.” (Moore, column 8, lines 66-67.) (Emphasis added.)

Thus, Moore’s reticle expressly comprises a single vertical cross-hair and a single horizontal cross-hair. In turn, Moore provides an explicit reason for this configuration:

“A further disadvantage of the prior art static means is the cluttering of the field of view of the riflescope. The many circles, lines, or sighting planes lead to confusion during critical or stressful aiming situations, as when time for aiming is limited.” (Moore, column 3, lines 27-31.)

Thus, Moore teaches directly away from the Examiner’s combination of Moore plus Reese.

With regard to horizontal cross-hairs 69 and 70 that are apparent in Figures 4(b’) and 4(c’), Moore notes:

“In this instance, the shooter will raise the aim of the firearm until the horizontal cross-hair image **69** is coincident with the phantom zero reference line 70. (The zero reference line **70** is shown for illustration purposes only and is to be understood not to exist in the actual sight picture.” (Moore, column 11, lines 27-29.)

Thus, Moore not only teaches directly away from the Examiner’s combination of Moore plus Reese, but Moore also teaches directly away from the plurality of simultaneously visible horizontal cross-hairs of the present application.

In addition, Moore's only aiming point is the intersection between the only cross-hairs to be found on Moore's reticle *i.e.*, the primary vertical cross-hair and the primary horizontal cross hair:

“And, as always, once the microcontroller has activated the correct setting indicator **73**, for indicating the proper setting of the adjustments, the shooter takes dead aim, positioning the cross-hairs' intersection exactly where he wishes the bullet to impact the target. All guesswork for achieving proper holdover is eliminated.” (Moore, column 12, lines 39-45.)

To the contrary, the aiming point of the ballistics calculator system of the present application uses “said secondary horizontal cross-hairs and said secondary vertical cross-hairs to identify an aiming point for hitting the target.” (Claim 45.)

Hence, contrary to the Examiner's arguments, Moore's disclosure expressly leads the ordinary artisan away from, not towards, making the Examiner's combination of Moore plus Reese. Merely because the references could be combined or modified does not render the resultant combination obvious unless the prior art suggests the combination.^{4,5} The Applicants submit that the Examiner's references cannot be considered collectively until the Examiner points to evidence of a motivation to combine the Examiner's specific references. The purpose behind this obligation is to prevent the Examiner, as here, from using the invention itself together with hindsight reconstruction to defeat the patentability of the invention. Moreover, the law does not regard the Examiner as one skilled in the art. (“[T]he examiner's assumptions do not constitute the disclosure of the prior art.”⁶ “[W]hen the PTO asserts that there is an explicit or implicit teaching or suggestion in the prior art, it must indicate where such a teaching or suggestion appears.”⁷ “[B]road, conclusory statements regarding the teachings of multiple references, standing alone, are not ‘evidence.’”⁸)

The Applicants respectfully note that the Examiner's references individually and

⁴ *In re Mills*, 916 F.2d 680, 682, 16 USPQ2d 1430, 1432 (Fed. Cir. 1990).

⁵ MPEP §2143.01.

⁶ *In re Ricjckaert*, 28 USPQ2d 1955 at 1956 (Fed. Cir. 1993).

⁷ See *Id.* At 1957.

⁸ *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614 (Fed. Cir. 1999).

collectively fail to teach or suggest making the Examiner's combination. Thus, the Examiner's references fail to establish *prima facie* obviousness of the claims.

In view of the above, the Applicants respectfully request that this rejection be withdrawn.

c. There is no Reasonable Expectation of Success in the Examiner's Combination of Moore and Reese

In the Office Action of March 30, 2007 the Examiner notes:

"Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the reticle with the specific cross-hairs as suggested by Reese with the ballistic calculator as disclosed by Moore." (Office Action of March 30, 2007, pages 4-5.)

The Applicants respectfully disagree. Reese does not teach or suggest the ballistics calculator system of the presently claimed invention. Accordingly, Reese provides no instruction, teaching or suggestion to the ordinary artisan how to go about combining the vast combinations of markings of Reese's reticles with Moore to arrive at the ballistics calculator system of the present application. Alone and in combination, Moore and Reese fail to teach, suggest or instruct the artisan of ordinary skill how to go about selecting and operating components of the ballistics calculator system of the present application. Moore is silent. Reese is silent.

In the Final Office Action of March 30, 2007 the Examiner has not advanced any evidence in support of the contention that the ordinary artisan using the apparatus of Moore and the Design Patent of Reese, would have a reasonable expectation of success in arriving at the ballistics calculator system of the present application. Because the Examiner is not able to show that a reasonable expectation of success may be found in Moore plus Reese, the third prong of a *prima facie* case of obviousness is defective, as are prongs one and two.

In view of the above, the Applicants respectfully request that this rejection be withdrawn.

2. Heidmann in View of Wascher

In the Office Action of March 30, 2007, claims 52 and 54 are rejected under 35 USC 103(a) as allegedly being unpatentable over Heidmann as applied to claim 45, and further in view of Wascher *et al.* (US Patent #5,491,546) (hereinafter “Wascher”).

In the Office Action of March 30, 2007 the Examiner notes:

“Although Heidmann *et al.* does not expressly disclose at least some of the secondary horizontal and vertical cross-hairs having identifying marks, and the reticle including range finding markings on the reticle, Wascher *et al.* does.”
(Office Action of March 30, 2007, page 5.)

The Applicants respectfully disagree. Heidmann does not teach or suggest a reticle with a plurality of visible secondary vertical cross-hairs at predetermined distances along at least some of the visible secondary horizontal cross-hairs of the present application. In addition, Heidmann does not teach or suggest the limitation “an output using said secondary horizontal cross-hairs and said secondary vertical cross-hairs to identify an aiming point for hitting the target” because Heidmann does not teach or suggest the visible secondary horizontal cross-hairs and visible secondary vertical cross-hairs of claim 45. Wascher does not remedy these defects. Accordingly, Heidmann in view of Wascher does not teach or suggest the ballistics calculator system of the present application.

In view of the above, the Applicants request that this rejection be withdrawn.

3. Heidmann in View of Cohen

In the Office Action of March 30, 2007, claim 74 is rejected under 35 USC 103(a) as allegedly being unpatentable over Heidmann as applied to claim 45, and further in view of Cohen (US Patent # 5,375,072) (hereinafter “Cohen”).

In the Office Action of March 30, 2007 the Examiner notes:

“Although Heidmann et al. does not expressly disclose that the device comprises an elevation knob and the system providing an output of how much the knob should be turned to adjust a position of the target acquisition device relative to the firearm, Cohen does.” (Office Action of March 30, 2007, page 5.)

The Applicants respectfully disagree. Heidmann does not teach or suggest a reticle with a plurality of visible secondary vertical cross-hairs at predetermined distances along at least some of the visible secondary horizontal cross-hairs of the present application. In addition, Heidmann does not teach or suggest the limitation “an output using said secondary horizontal cross-hairs and said secondary vertical cross-hairs to identify an aiming point for hitting the target” because Heidmann does not teach or suggest the visible secondary horizontal cross-hairs and visible secondary vertical cross-hairs of claim 45. Cohen does not remedy these defects. Accordingly, Heidmann in view of Cohen does not teach or suggest the ballistics calculator system of the present application.

In view of the above, the Applicants request that this rejection be withdrawn.

III. CONCLUSION

All grounds of rejection of the Final Office Action of March 30, 2007 have been addressed and reconsideration of the application is respectfully requested. It is respectfully submitted that the Applicant's claims as amended should be passed into allowance. Should the Examiner believe that a telephone interview would aid in the prosecution of this application the Applicants encourage the Examiner to call the undersigned collect at (608) 218-6900.

Dated: 4/17/07



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